

**REMARKS**

Claims 1-6, 10-20, 24-34, 38-51 are pending in the present application. By this Response, claims 1, 10-15, 24-29 and 38-42 are amended, claims 7-9, 21-23 and 35-37 are canceled, and claims 43-51 are added. Independent claims 1, 15 and 29 are amended to include features from canceled dependent claims 7, 21 and 35 and to recite that the outgoing message includes content that is automatically determined based on the geographical location of the portable device, first preferences of a user of the portable device, and second preferences of an owner/operator of an establishment at the geographical location of the portable device. Support for this additional feature to claims 7, 21 and 35 may be found at least in originally filed claims 9, 14, 23, 28, 37 and 42, page 10, lines 7-23, and page 11, lines 7-30. Claims 10-14, 24-28, 30-34 and 38-42 are amended for clarification purposes only based on the cancellation of claims 7-9, 21-23 and 35-37, and to be consistent with the amendments made to independent claims 1, 15 and 29.

Claims 43-51 are added to recite additional features of the present invention. Support for the addition of claims 43, 46 and 49 may be found at least at page 12, lines 13-15. Support for the addition of claims 44, 47 and 50 may be found at least on page 11, line 31 to page 12, line 3. Support for the addition of claims 45, 48 and 51 may be found at least at page 12, line 26 to page 13, line 9. No new matter has been added by the addition of claims 43-51. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

**I. Telephone Interview**

Applicants thank Examiner Lee for the courtesies extended to Applicants' representative during the November 10, 2004 telephone interview. During the telephone interview, the above amendments to the claims were discussed. Examiner Lee stated that the above amendments overcome the cited references and combinations of cited references used as a basis of rejection in the previous Office Action. Therefore, it is Applicants' understanding that, pending an updated search, the present claims now stand

in condition for allowance. The substance of the telephone interview is summarized in the following remarks.

## **II. Allowable Subject Matter**

Applicants thank the Examiner for the indication of allowable subject matter recited in claims 14, 28 and 42. However, for the reasons stated during the telephone interview, and set forth hereafter, Applicants respectfully submit that all of the claims now stand in condition for allowance.

## **III. 35 U.S.C. § 102(b), Alleged Anticipation of Claims 1-6, 15-20 and 29-34**

The Office Action rejects claims 1-6, 15-20 and 29-34 under 35 U.S.C. § 102(b) as being allegedly anticipated by Grube et al. (U.S. Patent No. 5,778,304). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Applicants respectfully submit that Grube does not identically teach every element of the claimed invention arranged as they are in the claims, as discussed hereafter.

Grube teaches a system and method for providing communication services based on geographic location. With the system of Grube, a communication resource controller receives the location of a particular communication unit and a particular service request. The communication resource controller accesses a database and determines whether that particular service request is restricted in the area that the unit is located. If the service is restricted in that area, the communication unit's request is denied. Upon determining the

restriction, the communication resource controller transmits a message to the communication unit indicating the restriction.

Amended claim 1, which is representative of the other rejected independent claims 15 and 29 with regard to similarly recited subject matter, reads as follows:

1. A method of managing operation of a portable device, comprising:  
determining a geographical location of the portable device, in response to receiving a communication destined for the portable device;  
determining if the geographical location of the portable device is within a geographical area of restricted use of the portable device;  
restricting use of the portable device based on the determination of whether the geographical location of the portable device is within a geographical area of restricted use; and  
sending an outgoing message to a source of the communication if use of the portable device is restricted, wherein the outgoing message includes content automatically determined based on the geographical location of the portable device, first preferences of a user of the portable device and second preferences of an owner/operator of an establishment at the geographical location of the portable device.  
(emphasis added)

Grube does not teach or suggest sending an outgoing message to a source of a communication if use of the portable device is restricted, wherein the outgoing message includes content automatically determined based on the geographical location of the portable device, first preferences of a user of the portable device, and second preferences of an owner/operator of an establishment at the geographical location of the portable device. Grube does not even mention sending an outgoing message to a source of a communication that is destined for a portable device. While Grube mentions the sending of messages, these messages are sent to the portable device to inform the portable device of the restrictions for the area in which the portable device is located. Thus, Grube does not teach each and every feature of independent claims 1, 15 and 29.

In view of the above, Applicants respectfully submit that Grube does not teach each and every feature of independent claims 1, 15 and 29 as is required under 35 U.S.C. § 102(b). At least by virtue of their dependency on claims 1, 15 and 29, respectively, Grube does not teach the features of claims 2-6, 16-20 and 30-34. Accordingly,

Applicants respectfully request withdrawal of the rejection of claims 1-6, 15-20 and 29-34 under 35 U.S.C. § 102(b).

**IV. 35 U.S.C. § 103(a), Alleged Obviousness of Claims 7-9, 11-13, 21-23, 25-27, 35-37 and 39-41**

The Office Action rejects claims 7-9, 11-13, 21-23, 25-27, 35-37 and 39-41 as being allegedly unpatentable over Grube et al. in view of da Silva (U.S. Patent No. 6,496,703). This rejection is moot with regard to canceled claims 7-9, 21-23 and 35-37 and is respectfully traversed with regard to the remaining claims.

As discussed above with regard to independent claims 1, 15 and 29, from which claims 11-13, 25-27 and 39-41 depend, Grube does not teach or suggest sending an outgoing message to a source of a communication if use of the portable device is restricted, wherein the outgoing message includes content automatically determined based on the geographical location of the portable device, first preferences of a user of the portable device, and second preferences of an owner/operator of an establishment at the geographical location of the portable device. Furthermore, Grube does not suggest such a feature either since Grube is not concerned with sending a message to a source of a communication destined for the portable device but rather is directed to sending a message to the portable device informing the portable device of the restriction for the current location of the portable device.

The da Silva reference, likewise, does not teach or suggest such a feature either. The da Silva reference teaches a system for disabling wireless communication devices. With the da Silva mechanism, power monitor units (PMUs) receive electronic serial numbers (ESNs) from portable devices and determines whether to disable the portable device in the particular zone associated with the PMUs. Various lists of ESNs that are to be disabled or to not be disabled within the zone are used to determine whether to disable a particular device sending a particular ESN. The da Silva mechanism further enables emergency calls to not be disabled in the zones (column 9, lines 33-42) and also provides for messages stating that the cellular phone is located in a prohibited area and cannot be contact at this time to be sent to a person calling the disabled phone (column 9, lines 28-

30). Moreover, the call may be routed into the cellular telephones message mail box if the cellular telephone is disabled (column 9, lines 30-31).

While da Silva teaches that a message may be sent to a caller indicating that the called cellular phone is located in a prohibited area and cannot be contacted, da Silva does not teach or suggest that the content of such a message is automatically determined based on the geographical location of the portable device, first preferences of a user of the portable device and second preferences of an owner/operator of an establishment at the geographical location of the portable device. Rather, with the da Silva mechanism, the same general message would be sent to the caller regardless of which prohibited area the cellular telephone is in. Furthermore, da Silva never takes into consideration any preferences of a user of a portable device or preferences of an owner/operator of an establishment at a location of the portable device when determining the content of a message sent to a caller.

Since neither Grube nor da Silva teach or suggest this feature of independent claims 1, 15 and 29, any alleged combination of Grube and da Silva still would not result in this feature being taught or suggested. Because claims 11-13, 25-27 and 39-41 depend from claims 1, 15 and 29, respectively, they incorporate the features of their respective independent claims and thus, are not obviated by the alleged combination of Grube and da Silva for the reasons stated above.

In view of the above, Applicants respectfully submit that neither Grube nor da Silva, either alone or in combination, teach or suggest the features of independent claims 1, 15 and 29. At least by virtue of their dependency on claims 1, 15 and 29, respectively, Grube and da Silva, either alone or in combination, do not teach or suggest the features of dependent claims 11-13, 25-27 and 39-41. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 11-13, 25-27 and 39-41 under 35 U.S.C. § 103(a).

**V. 35 U.S.C. § 103(a), Alleged Obviousness of Claims 10, 24 and 38**

The Office Action rejects claims 10, 24 and 38 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Grube et al. in view of da Silva and further in view of Makela et al. (U.S. Patent No. 6,301,338). This rejection is respectfully traversed.

The deficiencies of Grube and da Silva with regard to the features of independent claims 1, 15 and 29, from which claims 10, 24 and 38 depend, respectively, have been discussed above. Makela does not provide for these deficiencies.

Makela is directed to a mechanism for activating a telephone's call answering equipment based on the number of the calling party. Makela teaches that the language of a message that is sent to the calling party may be selected based on the country code of the telephone number of the calling party (column 5, lines 61-66).

While Makela teaches the sending of a messages to calling parties and determining the language of the message that is to be sent based on the country code associated with the calling party, Makela does not teach or suggest that the content of the message is determined based on the geographical location of the portable device, the preferences of a user of the portable device and the preferences of an owner/operator of an establishment located at the geographical location of the portable device. To the contrary, Makela does not take into consideration the preferences of an owner/operator of an establishment located at a geographical location of the portable device. Furthermore, there is no suggestion in Makela to do so. Thus, even if Makela were combinable with da Silva and Grube, the combination still would not result in the invention as recited in independent claims 1, 15 and 29, from which claims 10, 24 and 38 depend.

In view of the above, Applicants respectfully submit that neither Grube, da Silva, nor Makela, either alone or in combination, teach or suggest the features of independent claims 1, 15 and 29. At least by virtue of their dependency on claims 1, 15 and 29, respectively, Grube, da Silva, and Makela do not teach or suggest the features of dependent claims 10, 24 and 38. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 10, 24 and 38 under 35 U.S.C. § 103(a).

#### **VI. Newly Added Claims 43-51**

Claims 43-51 are added to recite additional features of the present invention. Claims 43, 46 and 49 are added to recite that the identity of the establishment is included in the outgoing message if the first preferences of the user permit the identity of the establishment to be included in the outgoing message. Claims 44, 47 and 50 are added to

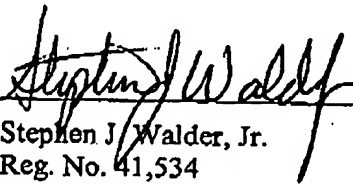
recite that the outgoing message includes an emergency contact number for a communication device associated with the establishment if the second preferences of the owner/operator of the establishment includes an emergency contact number for a communication device associated with the establishment. Claims 45, 48 and 51 are added to recite redirecting the communication to the communication device associated with the establishment and associated with the emergency contact number if the call is indicated to be an emergency call. Neither Grube, da Silva, nor Makela, either alone or in combination, teach or suggest such features.

#### VII. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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